

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte TODD ALLEN BERG, WILLIAM J. SWANSON and JERRY GRUDEM



Appeal No. 2005-0942
Application No. 09/550,471

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (mailed April 24, 2003) of claims 1, 3 to 5, 9, 45 to 49 and 53, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to apparatus and methods for attaching replacement heart valves (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1, 3 to 5, 9, 45 to 49 and 53 stand rejected under 35 U.S.C. § 103 as obvious over U.S. Patent No. 5,855,601¹ to Bessler et al. (Bessler).²

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (mailed December 16, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (filed October 27, 2003) and reply brief (filed February 17, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the Bessler patent, and to the respective

¹ Issued January 5, 1999.

² The rejection of these claims under 35 U.S.C. § 102(e) as being anticipated by Bessler was withdrawn by the examiner in the final rejection.

positions articulated by the appellants and the examiner.³ Upon evaluation of all the evidence applied in the obviousness rejection before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 3 to 5, 9, 45 to 49 and 53 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the applied prior art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). When obviousness is based on a single prior art reference, there still must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

³ On pages 5-6 of the answer, the examiner refers to a number of references of record that have not been applied in the rejection under appeal. These references will be given no consideration since they were not included in the statement of the rejection. See Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993).

Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In the obviousness rejection before us in this appeal, the examiner ascertained (answer, p. 3) that Bessler taught the claimed subject matter except for the claimed

"barbed fingers." The examiner thus agreed with the appellants that while Bessler teaches a plurality of barbs 64 extending outwardly from the outside surface of the stent member for fixing the heart valve in a desired position (see Figure 7), Bessler's barbs 64 do not constitute "barbed fingers" as claimed.⁴ The examiner then concluded that since Bessler's specification refers to the members 64 as "barbs," it would have been obvious to one having ordinary skill in the art to have utilized the well-know "barb" configuration for better anchoring.

The appellants argue that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require "barbed fingers." However, this limitation is not suggested by Bessler. In that regard, while Bessler's specification refers to the members 64 as "barbs," Bessler, by itself, provides no motivation to change the shape of those members from that shown in Figure 7. As such, Bessler does not teach or suggest the claimed "barbed fingers." To overcome this omission in the teachings of Bessler, the examiner made the determination that this difference would have been

⁴ See, for example, the appellants argument raised on pages 6-7 of the reply to final office action (filed October 1, 2002) and pages 5-6 of the brief.


obvious to an artisan. However, this determination has not been supported by any evidence that would have led an artisan to arrive at the claimed invention.


In our view, the only suggestion for modifying Bessler in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1, 3 to 5, 9, 45 to 49 and 53 under 35 U.S.C. § 103 is reversed.

To summarize, the decision of the examiner to reject claims 1, 3 to 5, 9, 45 to 49 and 53 under 35 U.S.C. § 103 is reversed.

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 2005-0942
Application No. 09/550,471

Page 8

FISH & NEAVE IP GROUP
ROPES & GRAY LLP
1251 AVENUE OF THE AMERICAS FL C3
NEW YORK, NY 10020-1105

JVN/jg